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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/981,392

10/17/2001

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10007682-1

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EXAMINER

BATURAY, ALICIA

ART UNIT

PAPER NUMBER

2441

NOTIFICATION DATE

DELIVERY MODE

01/20/2011

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHELL S. SIMPSON

Appeal 2009-006248
Application 09/981,392
Technology Center 2100

Before HUBERT C. LORIN, JEAN R. HOMERE, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-46 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We REVERSE.

THE INVENTION

The Appellant's claimed invention is directed a system and method for printing a controlled image including a predetermined graphic symbol, such as for example a signature on a check or other document. (Spec. 2:9-12). Claim 1, reproduced below with the numbering in brackets added, is representative of the subject matter of appeal.

1. From a client program in a web-based environment, a method for controlling production and display of an image represented by data generated at a source service, said data representing at least in part a predetermined graphic symbol referencing a particular symbol set, said method comprising the steps of:
 - accessing said source service;
 - dynamically generating a printable version of said image represented by said data at said source service under interactive control of said client program, said printable version including said predetermined graphic symbol referencing said particular symbol set;
 - referencing said printable version of said image represented by said data from a composition stored in an imaging store;
 - accessing said composition from a destination service; and
 - [1] if said destination service contains said particular symbol set and if said destination service is instructed to produce said printable version of said represented image, then forwarding said printable version of said represented image to said destination service

and then producing said represented image including said predetermined graphic symbol under interactive control by said client program, wherein said particular symbol set identifies mapping characteristics for producing said predetermined graphic symbol on said represented image.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Shima	US 6,369,909 B1	Apr. 9, 2002
Powers	US 6,438,584 B1	Aug. 20, 2002
Adamske	US 6,615,234 B1	Sep. 2, 2003
Savoray	US 6,631,200 B1	Oct. 7, 2003

The following rejections are before us for review:

1. Claims 1-7, 11-13, 18-23, 25-35, 37-43, and 46 are rejected under 35 U.S.C. § 103(a) as unpatentable over Adamske and Savoray.
2. Claims 8, 14-16, and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Adamske, Savoray, and Powers.
3. Claims 9-10, 34, and 44-45 are rejected under 35 U.S.C. § 103(a) as unpatentable over Adamske, Savoray, and Shima.
4. Claims 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Adamske, Savoray, Powers, and Shima.

THE ISSUES

With regards to claim 1 and its dependent claims the issue turns on whether Adamske and Savoray disclose claim limitation [1]. With regards to the remaining claims, the issue turns on whether Adamske and Savoray disclose a similar claim limitation.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:²

FF1: Savoray is directed to a method for producing an electronic signature which is verifiable and has the visual appearance of a true-life, handwritten manual signature (Col. 3: 12-15). The main function of the conversion software is to convert a raster or bitmap image of a handwritten signature into a scalable font format (Col. 3:24-28).

FF2. Savoray at Col. 4:39-46 discloses the conversion of a signature raster image into a font by “hinting”. A hinted image 30 is produced from guidelines 28 by identifying hints. Types of hints include “stems” and “overshoot” controls.

FF3. Adamske has disclosed a system for delivering an electronic document over a network and printing a hard copy at a remote destination (Abstract). Adamske at Col. 9:19-28 discloses that users can access the print preview function to see all of the signatory signatures placed on the document to date. The document will be held until all designated signatories have signed before being released to the destination printer 40.

FF4. Savoray at Col. 4:39-46 and Adamske at Col. 9:19-28 do not disclose a particular symbol set that identifies mapping characteristics for producing a predetermined graphic symbol on a represented image.

² See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

The Appellant argues that the rejection of claim 1 is improper because the cited prior art fails to disclose claim limitation [1] (Br. 8-10, Reply Brief 2-3).

In contrast, the Examiner has determined that the cited claim limitation is shown by Savoray at Col. 4:39-46 and Adamske at Col. 9:19-28.

We agree with the Appellant. Claim limitation [1] requires:

[1] “if said destination service contains said particular symbol set and if said destination service is instructed to produce said printable version of said represented image, then forwarding said printable version of said represented image to said destination service and then producing said represented image including said predetermined graphic symbol under interactive control by said client program, *wherein said particular symbol set identifies mapping characteristics for producing said predetermined graphic symbol on said represented image*”. (Claim 1, emphasis added).

The Examiner has taken the initial position that the cited claim limitation [1] contains “if” statements that are not requirements in the claim (Ans. 29-30). We disagree and find the claim to require the method to handle the situations contained in the “if” statements as well. Further, an argued portion of the cited claim limitation [1] requires “*wherein said particular symbol set identifies mapping characteristics for producing said predetermined graphic symbol on said represented image*” and in this claim the “wherein” clause makes the clause a claim limitation. The Examiner has stated that this portion of the cited claim limitation [1] is found at Savoray and Adamske (Ans. 30) but we disagree and do not find Savoray at Col. 4:39-46 or Adamske at Col. 9:19-28 to disclose this (FF4). Savoray discloses the

conversion of a signature raster image into a font by “hinting” (FF2) but not the claimed particular symbol set or mapping characteristics for producing a graphic symbol on the image (FF4). Adamske has disclosed that the document will be held until all designated signatories have signed before being released to the destination printer (FF3) but also does not show the claimed particular symbol set or mapping characteristics for producing a graphic symbol on the image (FF4). For these reasons the rejection of claim 1 and its dependent claims is reversed. Independent claims 25 and 38 contain similar claim limitations and the rejection of these claims as well as their dependent claims is reversed for the same above reasons.

DECISION

The Examiner’s rejection of claims 1-46 is reversed.

REVERSED

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